

AMENDMENTS TO THE DRAWINGS

Please enter the attached replacement sheet having original Figure 2b and amended Figure 2c. No changes have been made to Figure 2b, and no new matter has been added.

REMARKS/ARGUMENTS

The election/restriction requirement dated December 3, 2007 has been considered. In compliance with 35 U.S.C. § 121, Applicant hereby elects, with traverse, claims readable on Species I, illustrated by Figure 2a. Applicant believes that claims 1-8 and 10 are readable on Species I, and that at least claims 1 and 2 are generic.

The Office Action indicates that reference number “248” refers to two different elements with regard to Figure 2c, and requests appropriate correction. Applicant has amended Figure 2c and corresponding text on page 2, lines 12-20 by deleting the duplicative reference “248” and introducing reference number “249.” No new matter has been added.

Applicant respectfully submits that the election/restriction requirement is improper on several grounds. The MPEP provides that the Examiner should make a proper requirement as early as possible in the prosecution, in the first action if possible. MPEP § 811. The present election/restriction requirement is the second election/restriction requirement dispatched by the same Examiner. This second election/restriction requirement follows full consideration, searching, and examination of claims 1-18 by the Examiner, including dispatching of a first office action on the merits and subsequent withdrawal of all rejections in response to Applicant’s responsive communication to same.

The MPEP requires that, before making a restriction requirement after the first action on the merits, the Examiner will consider whether there will be a serious burden if restriction is not required. Applicant respectfully submits that the present election/restriction requirement fails to provide an explanation as to why, after the Examiner has already fully considered, searched, and examined claims 1-18, there will be a serious burden if restriction is not required. MPEP § 811.

In order to establish reasons for insisting upon restriction, the Examiner must explain why there would be a serious burden on the Examiner if restriction is not required. (See, MPEP § 808.01(a) which references MPEP § 808.02). To comply with this requirement, the Examiner must show by appropriate explanation one of the following (A) separate classification; (B) separate status in the art when they are classifiable together, or (C) a different field of search. (MPEP § 808.02). The Examiner has not provided any explanation as to why there would be a serious burden if restriction was not required as required by

MPEP § 808.01(a) and § 808.02. For at least these reasons, the election of species requirement is in error and must be withdrawn.

Moreover, Applicant respectfully asserts that the Examiner's identification of species in the Office Action is in error and does not comply with the mutually exclusive provision of MPEP § 806.04(f). A requirement for restriction to a single species may be proper if the species are mutually exclusive. Species are always the specifically different embodiments. MPEP § 806.04(e). Claims to be restricted to different species must be mutually exclusive. MPEP § 806.04(f).

Regarding Species IV identified in the Office Action as illustrated by Figure 3, Applicant's disclosure teaches that:

FIG. 3 shows a light-emitting stylus 310 that includes a side, or auxiliary, switch 320 for activating or changing properties of an emitted light beam B regardless of whether a tip switch (not indicated) is activated. [page 10. lines 1-3, *emphasis added*]

Applicant's disclosure regarding the stylus illustrated in Figure 3 clearly contemplates inclusion of a tip switch, such as those shown in Figures 2a, 2b, and 2c, for example. Because Applicant's disclosure describes the stylus shown in Figure 3 as being combinable with a tip switch such as those shown in Figures 2a, 2b, and 2c, Species IV is not mutually exclusive relative to Species I, II, and III.

Regarding Species I, II, and III illustrated in Figures 2a, 2b, and 2c, respectively, Applicant's disclosure describes each of these figures as showing embodiments of "a switch mechanism for changing a property of light emitted by a light-emitting stylus." Page 21, line 23–page 22, line 2. With particular reference to Species II and III illustrated in Figures 2b and 2c, respectively, the switch mechanism shown in Figure 2c may be viewed as substantially similar to that shown in Figure 2b with the addition of lens 249. As such, the species illustrated in Figures 2b and 2c may be used in combination in the same embodiment and are not disclosed as being mutually exclusive embodiments.

The features of Species IV and any of Species I, II, and III identified by the Examiner can coexist in the same embodiment under the disclosure. The features of Species II and III

identified by the Examiner can coexist in the same embodiment under the disclosure. With regard to the Species I and other combinations of the identified Species, the Office Action fails to provide the requisite showing of why there would be a serious burden on the Examiner if restriction is not required, particularly in view of the Examiner's prior consideration, searching, and examination of claim 1-18 as discussed previously.

In the above-made arguments, Applicant is contesting the propriety of the Examiner's election of species restriction requirement. Applicant, however, is not traversing on the ground that the "species" identified by the Examiner are not patentably distinct, but rather is asserting that the basis for requiring election between species is not supported.

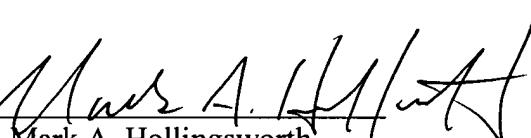
Applicant respectfully reminds the Examiner that, upon allowance of generic claim 1 or 2, Applicant is entitled to consideration of claims to additional species, including those identified by the Examiner, pursuant to 37 CFR 1.141.

Reconsideration and withdrawal of the election/restriction requirement is respectfully requested. If the Examiner has any questions or comments, a telephone call to the Applicant's Representative at the number provided below is invited.

Respectfully submitted,

HOLLINGSWORTH & FUNK, LLC
8009 34th Avenue South, Suite 125
Minneapolis, MN 55425
952.854.2700

By:


Mark A. Hollingsworth
Reg. No. 38,491